



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/595,056 | 01/20/2006 | Michael Steffen | 72.105 | 1915 |
| 23598 7590 11/03/2009 BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203 | | | | |
| EXAMINER | | | | |
| SORKIN, DAVID L. | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 11/03/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary

Application No.

10/595,056

Applicant(s)

STEFFEN, MICHAEL

Examiner

DAVID L. SORKIN

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/003)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 7-10 remain withdrawn from consideration, there being no allowable linking claim.

Drawings

2. The drawings are objected to because Fig. 1 includes German rather than English text. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to for referring to claims by number, including canceled claims. Outside of the claims, the specification should not refer to claims by number because claims may be renumbered before or after prosecution, amended or canceled.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 15-19, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Taking independent claim 17 as an example, the new recitation of the combination of the "operating state change device" and "automatic operation switch" is considered new matter. This is because according to the originally filed application, for example original claim 1, the term "operating state change device" collective refers to elements 6-1, 6-2, 8, 9 and 10, which element 9 is the automatic operation switch. In other words, "the automatic operation switch" is a subportion of the "operating change device", not an element distinct therefrom. Similarly, "periodic duration switch" and "reverse switch" are subcomponents of the "operating state change device".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the corresponding structure for the limitation "operating state change means for automatically reversing the direction of the electric motor at periodic time intervals...". According to the originally filed application, for example original claim 1, the term "operating state change device" collective refers to elements 6-1, 6-2, 8, 9 and 10, which element 9 is the automatic operation switch. However, it is unclear if the new means-plus-function corresponds to these five elements in combination, or if some subcombination(s) thereof would be considered corresponding structure(s).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6 and 15-22 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/61344 (which corresponds to Jordan et al US 6,808,384; all column and line number herein below are those of the English language US document). Jordan discloses a device comprising an electric motor (4); a vibrator housing (1); a rotatable imbalance device (8); and a main switch (see col. 4, line 54). No other structural elements are positively recited as required elements of the claimed structure. As held in *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) "recitation with respect

to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus". Nonetheless, Jordan discloses an operating state change device (see 4, lines 21-56: "frequency converter", "switch housing", "a switch from reversing the direction of rotation"). Regarding claims 15 and 16, Jordan further discloses another switch in addition to the mains switch (see col. 4, lines 52-56). Regarding claims 17-22, Jordan discloses a device comprising an electric motor (4); a vibrator housing (1); a rotatable imbalance device (8); a main switch (see col. 4, line 54); and an operating state change device (see 4, lines 21-56: "frequency converter", "switch housing", "a switch from reversing the direction of rotation"). Jordan further discloses another switch in addition to the mains switch (see col. 4, lines 52-56).

Response to Arguments

10. Applicant has added new claims, including independent claim 17 which clearly positively recites "an operating state change device" as an element which the claimed device comprises. On the other hand, previously presented independent claim 1 makes clear that the operating state changed device is not one of the elements which the claimed vibrator device is required to comprise, but instead explains that operating state change device is something "by which the internal vibrator device is able to be operated". Nonetheless, Jordan discloses an operating state change device (see 4, lines 21-56: "frequency converter", "switch housing", "a switch from reversing the direction of rotation"). Apparatus claims must require a structure physically different from the prior art, whether the claims recite structure explicitly or functional. As held in

In re Schreiber 44 USPQ2d 1429 (Fed. Cir. 1997) "choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in Swinehart , 439 F.2d at 213, 169 USPQ at 228: where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on". Applicant makes comments concerning software patenting, which really isn't particularly relevant to this instant application, however, if the software is being claimed as an apparatus or product, the apparatus of product must be physically different from the prior art. For example, if claimed as computer readable media, an example of the physical difference may be a punch card with a pattern of holes previously unknown. An algorithm itself is not statutory subject matter.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID L. SORKIN whose telephone number is (571)272-1148. The examiner can normally be reached on Mon.-Fri. 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter D. Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID L. SORKIN/
Primary Examiner, Art Unit 1797